

REMARKS

Applicant wishes to thank the Examiner for signifying the allowable subject matter of method claims 12-16 and 29-32. Applicant has amended the application in accordance with the Examiner's comments concerning allowable subject matter of these claims. While the Applicant respectfully disagrees with the Examiner's conclusions concerning the asserted absence of structure in the now canceled system claims and their asserted disclosure in Tagawa (U.S. Patent no. 5,732,398), for purposes of advancing prosecution in an expeditious manner Applicant has submitted a new set of system claims (37-52). The new system claims may be compared with the allowed method claims. Accordingly, Applicant respectfully requests that the Examiner reconsider the application in accordance with the amendments and comments herein.

A. Claim rejections - 35 U.S.C. § 112, first paragraph

The Examiner has rejected claim 12 under the enablement requirement of § 112. The Examiner argues that the claim's reference to "congruency matching" and the related wherein clause is not enabled by the specification. The Examiner asserts that the specification does not specifically recite the phrase "congruency matching". Applicant respectfully disagrees.

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). Applicant submits that when the disclosure of the application is taken into consideration, one skilled in the art would be able to make or use the invention without undue experimentation.

First, Applicant notes that the phraseology with regard to congruency matching existed in the specification when it was

originally filed. Applicant refers the Examiner to claims 1, 9 and 12 as originally filed, which all recite the congruency matching terminology. The disclosure of the specification includes the text of the claims when originally filed. See, e.g., *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

Second, with regard to the enablement of such a feature, Applicant submits that in addition to the claims, the specification describes a preferred method by which the identified matching can be implemented. With regard to original claim 12, congruency matching was originally described as follows:

compiling based on a congruency matching of criteria comprising any of: geographic distributions, type of product, time considerations, cost, defined restrictions, intelligent agents, and distribution channel limitations

The detailed description at length describes how matching based on geographic distribution, type of product, time considerations, cost, defined restrictions, intelligent agents, and distribution channel limitations can be implemented. For example, the Examiner is referred to the Summary of the Invention section where matching based on the identified criteria is introduced. See Specification at page 6, lines 18-23. The Specification then goes on to illustrate packaging guidelines and restrictions that may be matched for controlling the packages that can be generated. See, e.g., Specification at page 13, line 13 to page 14, line 19 and page 16, line 21 to page 17, line 19. Figures 9a and 9b specifically illustrate, and the specification describes in detail, an algorithm for building packages utilizing such matching criteria. See, e.g., page 17, line 20 to page 19, line 4. For example, the specification illustrates the matching of different products. See, e.g., Specification, page 18, lines 1-3. Compiling products

of common date ranges and geography are described. See, e.g., Specification, page 18, lines 4-6 and 17-18. In fact, specific real world examples with matching are illustrated in the specification. See, e.g., Specification page 21, line 13 to page 23, line 14. In short, when considered in its totality, the specification does describe congruency matching such that an individual skilled in the art could practice the invention.

Given the extent and detail of the entire disclosure, Applicant submits that a person skilled in the relevant arts of the invention, which would include computer programmers as noted in the specification, would be able to practice the invention without undue experimentation. See Specification, page 23, lines 24-25.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

B. Claim Objections - 35 U.S.C. § 112, second paragraph

In accordance with the Examiner's request, Applicant has amended claim 29 to address the antecedent basis informality identified. Applicant believes that the change corrects claims 29-32. Withdrawal of the rejection is respectfully requested.

C. Conclusion

Accordingly, the pending claims recite subject matter neither taught nor suggested by the relied on references. Thus, it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

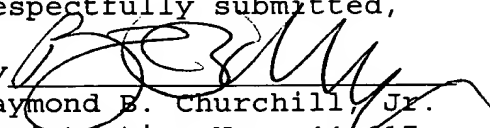
Application No.: 09/551,519

Docket No.: CENDAN 3.0-026

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: February 22, 2005

Respectfully submitted,

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